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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
NGUYEN, CUONG H	

ART UNIT	PAPER NUMBER
3661	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/365,651	TREYZ ET AL.	
	Examiner	Art Unit	
	CUONG H. NGUYEN	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 August 1999* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the decision of the BPAI received on 5/15/2006, which papers have been placed of record.

2. Claims 21-40 are pending in this application.

Response:

3. Because the BPAI only affirm-in-part of examiner rejections; the examiner respectfully presents a new ground of rejection on the claims that not being affirmed. This is a Non-Final Rejection; when making decision of patentability, the BPAI reminded the examiner to take Kodak, and Fujinet.com references into account for a statutory rejection (these reference suggests what applicants claim). The examiner respectfully submits Fujifilm.net (an IDS filed on 8/02/1999) is formally included in statutory rejections herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Re. to claims 21, 23-30: They are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of fujifilm.net article (in 8/02/1999 IDS – a hardcopy of this article was printed out on 8/01/1999), and further in view of Nozaki et al., (US Pat. 6,349,194).

Oberg teaches an equipment that allows a user to order image-based products over the Internet, comprising:

- An order servicing computer that receives an uploaded digital image over the Internet; and digital printing equipment, wherein the order opportunity to view the uploaded digital image on-line over the Internet, wherein the order servicing computer is configured to provide the user with an opportunity to edit the uploaded digital image on-line over the Internet, wherein the digital printing equipment is configured to print the edited digital image to create a print for framing, (see **Oberg**, col.3 lines 34-53, Oberg's system is capable of creating a composite visual concept of a customer's order and allows the customer to adjust the color, size, width and other characteristics of frames and matting materials until the desired combination is achieved. "

And in col.7 lines 34-51 Oberg teaches a user selects the frame and review for satisfaction when matching to a print.

Oberg is silent on an opinion of BPAI: "*While the composite image does represent an edited digital image, we do not consider the printing of this image to be a print of the digital image for framing as claimed*", the examiner respectfully submits that fujifilm.net clearly teaches a process of: "As a Register Member, you can do:

- Edit, Store, and Organize your (digital) image ...
- Then have prints of your (digital) images delivered ..." (see fujifilm.net, List of Fujifilm.net Services) – this showed that fujifilm.net already has hardware, and software to produce prints, and a printer was used to print edit images in its online picture processing.

Oberg does not expressly disclose "*an order servicing computer is configured to present the user with an opportunity to select a given type of frame for the print*".

However, Nozaki et al. suggest that "a customer can change the sizes and positions of the image frame ... the customer desires to add frames, new frames of selected sizes ... or a selected

image frame (see Nozaki et al., col.13 lines 37-47) – this suggests that an online picture frame selection (or equivalents) already being suggested.

It would be obvious for one with ordinary skill in the art to implement Oberg 's ideas with Fujifilm.net and Nozaki et al. 's suggestions to edit a digital image online, select a frame for a picture, since a framed picture could be placed in many places and increasing good values to the picture – everything can do in a one-stop-shopping, the user doesn't have to go to a photo lab or camera shop to do those transactions; all above cited references are in the same specific application of digital images for picture-ordering online, then downloading/printing out said edit digital image.

B. Re. to claim 23: The rationales and references for rejection of claim 21 are incorporated.

Oberg also teaches that a servicing computer is configured to crop an uploaded image on-line (see Oberg, the abstract).

C. Re. to claim 24: The rationales and references for rejection of claim 23 are incorporated.

Oberg also discloses that an order computer is configured to set up an account by providing a name, e-mail address (see Oberg, col.2 lines 47-67 especially "...present images of frame moldings and colored accent matting that coordinate with the artwork."

And in col.3 lines 54-64 Oberg's system has been capable of generating a bill of material or order template that comprising a customer's name, address, and phone number, the products or component materials selected, etc. Oberg's system clearly calculates these features/figures at the user's request in an order summary (this shows that Oberg already suggests of setting up an account), Oberg also suggests that a password is used and is configured to provide text associated with an image using Internet (see Oberg, col.4 lines 1-9, and col.7 lines 14-33).

D. Re. to claim 25: The rationales and references for rejection of claim 23 are incorporated.

Oberg also teaches that a servicing computer is configured to change image to different colors (see Oberg, the Abstract, col.1 lines 20-47, col.2 lines 12-67, col.3 lines 7-16, col.3 lines 24-66, col.4 line 32 to col.5 lines 47, col.5 lines 60 to col.6 line 35, note that Oberg col.6 lines 63-67, discloses "*allows the customer to adjust sizes and colors of the frame and matting material once they are combined with the input image for viewing*" – after satisfying (by a customer) with edited images, the system's printer performs a print-out).

E. Re. to claim 27: The rationales and references for rejection of claim 21 are incorporated.

Oberg's computer is configured for a user to order frames of different colors and is configured to provide the user with an on-line opportunity to order albums of different materials.(see Oberg, the Abstract, col.3 lines 7-11, and col.3 lines 25-53).

F. Re. to claim 28: The rationales and references for rejection of claim 21 are incorporated.

Oberg teaches that the order servicing equipment defined in claim 21 wherein the order-servicing computer is configured to allow the user to add audio to uploaded digital image(s) over the Internet. (see Oberg, col.4 lines 32-57) – that is merely "an edit" to digital image processing.

G. Re. to claims 29-30: The rationales and references for rejection of claim 21 are incorporated.

Oberg teaches that the order servicing equipment is configured to provide the user with an on-line opportunity to select from different mat styles for corresponding selected frames (see Oberg, the abstract), and make orders (see Oberg, Fig. 2C, or fujifilm.net).

5. Claims 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of fujifilm.net article (in 8/02/1999 IDS, in view of Nozaki et al., (US Pat. 6,349,194), and further in view of Melissa A. Weisman's article.

a. Re. to claim 31: Oberg (col.3 lines 54-60) does not disclose that his computer is configured to email a message to a party other than the user over the Internet, wherein the message includes a URL that allows the party to view and order prints.

However, Weisman's article teaches this limitation ("forwarding" a message in the Internet - see Weisman, page 1; please note that fujifilm.net also clearly teaches of sharing/distributing digital pictures to different parties on Internet).

b. Re. to claims 32, 34: BPAI's opinion on page 11, 2nd para. is "*...the changing of backgrounds discussed in Weisman is the background of the album, (webpage) and not the background of the picture*". The examiner respectfully submits that "merging"/"substituting" image technology to reflect "a different background" in a picture that different from what originally photographed is not new at the time of invention; a motivation for this is creating a new picture with different interesting ideas to draw attentions of viewers (e.g., putting your image next to President Ronald Reagan, or putting your image on picture as "the richest person on earth" on Forbes magazine (or Times magazine) then processing a new picture with those backgrounds)

Weisman also teaches that the order servicing computer is configured to provide the user with an opportunity to order a print of a digital image that includes the user as a subject (see Weisman's article, it was suggested as ordering a picture of "a wedding guest"), and that includes a "background" different than the background against which the user was originally photographed (see Weisman, page 2, please note that "background" here can be anything changed from original picture).

It would be obvious to one of ordinary skill in the art to combine Oberg, Fujifilm.net, Nozaki, and Weisman to utilize a background of the picture for identification because artisans recognize that an identity for a person (e.g., a SSN, a date of birth, a location (e.g., a URL), an

account) or a different background may be necessary to specify in any ordering communication; these types of personal information are very helpful and convenient when using to verifying from different related parties (for recognizing identity).

c. Re. To claim 33: This "system" claim contains similar features as in system claims 21, 24, and 32. Therefore, similar rationales and references set forth for rejections of claims 21, 24, and 32 are combined for a rejection of claim 33 under 35 U.S.C.§ 103(a) on cited art of Oberg, Fujifilm.net, Weisman, and Nozaki et al.

BPAI's opinion that "*claim 33 recites two types of information associated with the pictures: an assignment title, which identifies the event and a customer list*" (see BPAI, page 7, 6th paragraph).

The examiner respectfully submits that merely for identification purpose, many practices have been required two separate/distinct information for verifying – if those two distinct information are correctly provided by a party, and a provider easily verifies them in his records (i.e., information associated with pictures: an assignment title, which identifies the event and a customer's name); this verifying practice has been an old and well-known process on many transactions that is appreciated by an online transaction such as photo processing on Internet.

d. Re. To claim 35: This "system" claim contains similar features as in a system claims 21 and 33. Therefore, similar rationales and references set forth for rejections of claims 21, and 33 are combined for a rejection of claim 35 under 35 U.S.C.§ 103(a) on cited art of Oberg, Fujifilm.net, Weisman, and Nozaki et al.

e. Re. To claim 36: This "system" claim contains similar features as in a "system" claims 23, and 33. Therefore, similar rationales and references set forth for rejections of claims 23 and 33 are

combined for a rejection of claim 36 under 35 U.S.C.§ 103(a) using Oberg, Fujifilm.net, Weisman, and Nozaki et al.

f. Re. To claim 37: This "system" claim contains similar features as in "system" claims 21, 25-26, and 32. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C.§ 103(a) using Oberg, Fujifilm.net, Weisman, and Nozaki et al.

g. Re. To claim 38: This "system" claim contains analogous features as in a system claim 21. The generic acts of viewing/ordering different frames for digital images are obvious to this computerized-application business. Therefore, similar rationales and references set forth for a rejection of claim 21 are applied for a rejection of claim 38 under 35 U.S.C.§ 103(a) using Oberg, Fujifilm.net, and Nozaki et al.

h. Re. To claim 39: This "system" claim contains analogous features as in system claims 32 and 38. Therefore, similar rationales and references set forth for rejections of claims 32 and 38 are combined for a rejection of claim 39 under 35 U.S.C.§ 103(a) using Oberg, fujifilm.net, Weisman, and Nozaki et al.

i. Re. To claim 40: This "system" claim contains similar features as in a system claim 21 and 38 because of Internet capability in communications is a fact. One of ordinary skill in the art would recognize that Internet is used to communicate anywhere in the globe. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C.§ 103(a) using Oberg, fujifilm.net, and Nozaki et al.

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of fujifilm.net, in view of Nozaki et al., (US Pat. 6,349,194), and in view of Plettinck et al., (US Pat.5,689,349).

The rationales and references for rejection of claim 21 are incorporated.

Oberg and Weisman do not disclose that an order equipment comprises packaging equipment.

However, Plettinck et al., suggest that idea in US Pat. 's Brief Summary Text portion (para.5): "*The method of the present invention is capable of many applications for printing color prints, such as packaging or pictures in periodicals or books.*" – therefore, this idea of packaging was suggested.

It would have been obvious for one with ordinary skill in the art to implement **Oberg** 's ideas with fujifilm.net, **Nozaki** et al. 's, and **Plettinck 's** suggestions to include a packaging equipment in the above claimed system for mailing finished products to customers according to ordering items in an online photo process as taught by fujifilm.net.

7. Re. to claim 26: It is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of fujifilm.net, in view of Nozaki et al., (US Pat. 6,349,194), further in view of Bruck et al.(US Pat. 6,008,836).

The rationales and references for rejection of claim 25 are incorporated.

Oberg suggests a computer is configured to change image color/contrast. Furthermore, Bruck et al. clearly define a selection of image's contrast to edit original images (see Bruck et al., claims 3, 8, 21 and specifically "*The user selects the contrast setting in accordance with the optimum contrast of the test pattern. After the user sets the contrast of the display to the proper position, he selects the continue anchor 83 to invoke the next picture adjustment screen*").

It would have been obvious for one with ordinary skill in the art to implement Oberg 's ideas with fujifilm.net, Nozaki et al., and Bruck et al. 's suggestion to select a frame for a picture for online photo processing, since Bruck et al. suggest in a digital world, a contrast could be easily

changed/edited in order to give a different image appearance in a online photo processing as taught by fujifilm.net.

Conclusion

8. Claims 21- 40 are not patentable.

Remark: The BPAI said that "*The examiner does not assert that Nozaki teaches a printer to print the digital image submitted over the Internet as claimed*", the examiner submits that both cited references of Oberg, and Nozaki et al. teach that a printer (see Oberg, output means 24 of FIG.1; see Nozaki, in Detailed Description Text (para. 13): "*the order information output unit 26 should be understood as a collective term for an electronic file generating device and a printer*" is used in their system, it is connected to the computer, its microprocessor – therefore, a photo image printer was recognized to be used for that printer because of a high printing resolution (as using in fujifilm.com).

9. These references are considered pertinent to applicants' disclosure:

- Melissa A. **Weisman**, Internet wedding albums reach far-flung relatives, The Patriot Ledger, Quincy, 10/21/1998 (from ProQuest).

- **Smart** et al. (US Pat. 6,185,371, filed on 12/28/1998, issued on 2/06/2001, US Class 396/6; 396/311; 396/429) "Photo finishing method, photo finishing apparatus, and system" where in 35 USC 103(a) rejection is used based on Smart claims 3-4, 6-7, 14-15.A photo finishing system includes film units, a remote look-up table, and photo finishing apparatus. The photo finishing apparatus has a reader to read identifiers on the film units, a communicator to interface with the look-up table to poll the table for photo finishing parameters for the film units, and a processor that generates digital images responsive to the photo finishing parameters. In a method, a film unit containing a plurality of captured images is received. A remote look-up table having a logical

memory unit uniquely associated with the film unit is accessed. The logical memory unit designates a plurality of photo finishing parameters for the film unit. The film unit is processed responsive to the photo finishing parameters. Information about the processing of the film unit is recorded in the logical memory unit.

- **Haneda**, (United States Patent 6,459,511, filed on 3/19/1998, issued on October 1, 2002; Current U.S. Class: 358/506; 358/302; 396/311; Foreign Application Priority Data Jul 29, 1994[JP]6-196213; Jul 29, 1994[JP]; 6-196214 Sep 30, 1994[JP] 6-261678; Jun 29, 1995[JP] 7-185012.) "Laboratory system, method of controlling operation thereof, playback apparatus and method, film image management method, image data copying system and method of copying image data" wherein Images of film that has been developed are captured by image sensing, thereby being converted to original digital image data representing these images. The original digital image data is converted to reduced digital image data representing images that are reduced in size. The reduced digital image data is stored on a user's disk, and the original digital image data is stored on a laboratory-recording medium together with an identification code identifying the roll of film. The identification code is applied to the film and to the user's disk on which the reduced digital image data has been stored. The original digital image data is read out of the laboratory-recording medium and photographs of the images represented by this data are printed. The identification code may be recorded on the user's disk instead of being applied thereto. A program (hypertext) for reproducing the images also is stored on the user's disk. Image data, information IX1 per each roll of film and information IX2 per each frame are read from photographic film having information-recording zones, and the image data and information are recorded on a user's disk. Resources comprising a video component (image data) such as a frame image or the like for being combined with a film image, and an audio component (sound data) such

as background music or narration are also recorded on the user's disk in advance. Slide-show program composed of information indicating a playback sequence, information relating to combinations of film images and video components and information for controlling the generation of sound is created in a playback apparatus and recorded on the user's disk. In accordance with the slide-show information, film images and video components are combined and displayed in a designated sequence and sound is played by the audio components. This presents a slide show. Image data is read out of a copy-source recording medium image by image, and reduced image data, which represents reduced images obtained by reducing the size of images represented by the image data read out of the copy-source recording medium, is created image by image. An image file including images read out of the copy-source recording medium and an index file including the reduced image data created are recorded, in mutually associated form, on a copy-destination recording medium in units of the copy-source recording medium.

- **Stroschin** et al., (US Pat. 5,453,926 - filed 5/25/1994), Touch screen system for a web folder (see Stroschin, claim 25 wherein copying/displaying an edited digitized image was disclosed).

- **Maniwa** et al., (US Pat. 5,768,483 with priority date: 9/26/1995), Method of reporting result of execution of print job in network system, method of setting scanning conditions in network system, and network printing/scanning system; wherein scanning images were put into a library/files for retrieval later.

- **Chretinat** et al., (US Pat. 6,167,806 with priority date: 3/11/1998), Device for controlling the printing of web materials in a rotary printing press (see Chretinat, claims 1-2, and 8 for disclosures of editing/inserting digital images on the web).

- FUJI PHOTO FILM CO. LTD, (DERWENT-ACC-NO: 2001-429341 with priority date: 8/11/1999), discloses about network access control method for online photograph service system as

pending application, involves printing photograph based on digital image data and purchase order information received from respective sources and external network.

- **Tsue** T. of FUJI PHOTO FILM CO. LTD, (DERWENT-ACC-NO: 2001-625032 with priority date: 3/29/2000), discloses about a template displaying method for network photograph service system as pending application, involves generating catalogs of templates, having user images, and displaying the catalogs.

- **Kono** et al., (PUB-NO: JP02001249990A, application date: 3/03/2000), disclose an image service system and computer readable storage medium, wherein they suggest of providing an image service system capable of facilitating ordering, improving convenience in terms of management and the efficiency of work and performing quick service.

- **Telepix** imaging provides unique digital imaging products and services for London drugs photo finishing needs, Canada Newswire, 9/16/1998; wherein it discloses about letting customers easily organize, upload and download their photos and photo creations; News Network,9/13/1996

- From Dialog Classic Web file 9,Kodaks new small office/home zoom digital camera, Newsbytes News Network, 9/15/1997, wherein Easy 2.0 software can allows simple changes and enhancements to images and then can e-mail/print/upload/place orders with print service. These steps are similar as what this pending application suggested.

- From DialogClassic Web™ file 9, **Kodak**'s new small office/home zoom digital camera, Newbytes News Network, 9/05/1997. This document discloses that a variety of digital photo editing software packages are available.

- From DialogClassic Web™ file 648, President and chief executive officer of Seattle Filmworks, Inc., Wall Street Corporate Reporter, 2/26/1996. This document discloses that online film processing are available.

- **Jahnke**, Kodak stays in the digital picture, 8/06/1999, CNN.com, this article reviews Kodak's film-processing activities including Kodak PhotoNet online and Kodak Picture Playground online.

- **Arar**, Get the picture, however you want it, 6/24/1999, CNN.com, this article discloses that a number of Web-based services are popping up to serve the rapidly expanding digital photography market; and Adobe Systems is a developer of the popular PhotoDeluxe image-editing software.

- From DialogClassic Web™ file 20, Telepix imaging provides unique digital imaging products and services for London drugs photo finishing needs, Canada Newswire, 9/16/1998.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuonghnguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3661